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09/815,819	03/23/2001	Wendell Brown	EVOI0009	6685

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Glenn Patent Group  
3475 Edison Way,  
Suite L  
Menlo Park, CA 94025

EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/815,819

Applicant(s)

BROWN ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9, 11-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-24 and 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30, line 1, recites the phrase "in real-time" and line 18 recites "speech-to-text conversion module". These two phrases are contradictory according to applicant's arguments (page 6 of 14) of real-time communication and the accepted definition in the art (see attached Newton's Telecom Dictionary definition). "Speech-to-text" conversion would require extensive processing to recognize the speech, independently or dependent on the speaker's voice pattern, which provides a time delay. It is further unclear and not known where in applicant's specification discusses or shows the speech-to-text 'Module' and how the conversion is processed as 'speech recognition' conversion into text is a complicated system that would limit real-time communication. Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 5-9, 11-24, and 26-33 rejected under 35 U.S.C. 102(e) as being anticipated by Casellini, Patent #6,404,860.**

Regarding claims 1 and 29, Casellini teaches a method and a computer readable storage medium storing instructions for controlling a telephone call to an instant messaging user, comprising:

- (a) (b) receiving at a call server a call directed to the user and identifying an instant messaging service used by the user (203-206 Fig. 4A);
- (c) sending an instant message to the user through the instant messaging service to offer the user one or more options for responding to the call (205-A Fig.4A, Fig.6, and col.4 lines 14-41);
- (d) if no response is received from the user within a predetermined period of time, controlling the call as specified in a default option (col.4 lines 59-64); and otherwise:
- (e) receiving an option selection from the user; and (f) controlling the call as specified in said selected option (209-210 Fig.4A and Fig.6); and

wherein the user selects an option to answer the call over the instant messaging service, the controlling step further comprises the steps of:

- (f1) if the instant messaging service is communicatively coupled to both a microphone and a speaker at the user's side, establishing an audio connection between the user and the caller(316 Fig.3, 500a Fig.6 and col.5 lines 6-25; options 1, 2, 4, or 5 also establishes an audio connection between the user and the caller); and
- (f2) if the instant messaging service is not communicatively coupled to both a microphone and a speaker at the user's side, establishing verbal-textual communication

between the caller and the user by enabling speech-to-text and/or text-to-speech conversion modules (500b Fig.6 and col.2 lines 51-67; the IMS service is not communicatively coupled to both a microphone and a speaker when the user chooses not to speak and selects the text-to-speech option).

Regarding claim 2, Casellini teaches the method of claim 1, further comprising determining a user name of the user for the instant messaging service (col.3 lines 37-44 and col.4 lines 14-27).

Regarding claim 3, Casellini teaches the method of claim 1, wherein said one or more options include one or more of the set of transfer the call, answer the call, take a message from the caller and play a message for the caller (500a Fig.6)

Regarding claim 5, Casellini teaches the method of claim 1, wherein said selected option is presented in said instant message as a hyperlink and said receiving said option selection comprises receiving a communication connection initiated by the user's selection of said selected option (500a Fig.6)

Regarding claim 6, Casellini teaches the method of claim 1, wherein said selected option is to play a message for the caller, the method further comprising recording a message from the user (Fig.6)

Regarding claim 7, Casellini teaches the method of claim 1, wherein said selected option is to play a message for the caller and said controlling comprises: converting a textual message provided by the user into audio; and playing said converted message for the caller (500b Fig.6).

Regarding claim 8, Casellini teaches the method of claim 1, wherein said selected option is to answer the call and said controlling comprises: establishing an audio connection between the user and said call server; and bridging the call onto said audio connection (500a Fig.6; options 1, 2, 4, or 5 establishes an audio connection between the user and the caller).

Regarding claim 9, Casellini teaches the method of claim 8, wherein said audio connection is established through the instant messaging service without further action by the caller (500a Fig.6; options 1, 2, 4, or 5 does not require further caller action).

Regarding claim 11, Casellini teaches a method of handling a telephone call for a subscriber, comprising:

- (a) (b) receiving at a call server a call for a subscriber and identifying a first computer-implemented instant messaging system used by the subscriber (203-206 Fig. 4A);
- c) sending a first instant message to the subscriber through the instant messaging system, wherein said first instant message includes a first set of options for handling the call and one or more of said first set of call handling options comprise links to said call server(205-A Fig.4A, Fig.6, and col.4 lines 14-41);

if the subscriber selects one of said first set of call handling options:

- (d) (e) receiving a communication connection from the subscriber, wherein said connection is initiated by the subscriber's selection of a call handling option that comprises a link; and handling the call as specified in said selected call handling option (209-210 Fig.4A and Fig.6); and

wherein the user selects an option to answer the call over the instant messaging service, the controlling step further comprises the steps of:

(e1) if the instant messaging service is communicatively coupled to both a microphone and a speaker at the user's side, establishing an audio connection between the user and the caller(316 Fig.3, 500a Fig.6 and col.5 lines 6-25; options 1, 2, 4, or 5 also establishes an audio connection between the user and the caller); and  
(e2) if the instant messaging service is not communicatively coupled to both a microphone and a speaker at the user's side, establishing verbal-textual communication between the caller and the user by enabling speech-to-text and/or text-to-speech conversion modules (500b Fig.6 and col.2 lines 51-67; the IMS service is not communicatively coupled to both a microphone and a speaker when the user chooses not to speak and selects the text-to-speech option).

Regarding claim 12, Casellini teaches the method of claim 11, further comprising: if the subscriber does not respond to said first instant message within a predetermined period of time, handling the call as specified in a default call handling option (col.4 lines 59-64).

Regarding claim 13, Casellini teaches the method of claim 11, further comprising: identifying the user by an original called number field of the call (col.3 lines 37-44 and col.4 lines 14-27).

Regarding claim 14, Casellini teaches the method of claim 11, further comprising: identifying the caller by a caller identification field of the call; wherein said first instant message includes an identifier of the caller (101 Fig.6)

Regarding claim 15, Casellini teaches the method of claim 11, wherein said links are hyperlinks to said call server (500a Fig.6)

Regarding claim 16, Casellini teaches the method of claim 11, wherein said receiving a call comprises receiving a call forwarded to said call server from a subscriber number originally dialed by the caller (500a Fig.6)

Regarding claim 17, Casellini teaches the method of claim 11, further comprising retrieving user names of the subscriber for one or more instant messaging systems (col.2 lines 60-65 and col.4 lines 14-27).

Regarding claim 18, Casellini teaches the method of claim 11, further comprising sending a second instant message to the subscriber through an instant messaging system different from said first instant messaging system, wherein said second instant message comprises a second set of call handling options (500b Fig.6)

Regarding claim 19, Casellini teaches the method of claim 18, further comprising:  
if the subscriber selects one of said second set of call handling options:  
receiving a return instant message from the subscriber, wherein said return instant message includes an identifier of a call handling option selected by the subscriber; and  
handling the call as specified in said selected call handling option (209-210 Fig.4A and Fig.6);

Regarding claim 20, Casellini teaches the method of claim 11, wherein said selected call handling option comprises transferring the call and said handling the call comprises: transferring the call from said call server to a telephone number identified by the subscriber (Fig.6).



Regarding claim 21, Casellini teaches the method of claim 11, wherein said selected call handling option comprises playing a message for the caller and said handling the call comprises: playing a message identified by the subscriber for the caller (Fig.6)

Regarding claim 22, Casellini teaches the method of claim 21, further comprising converting said identified message from text to audio prior to said playing (*Fig.6 and col.2 lines 14-41*).

Regarding claim 23, Casellini teaches the method of claim 21, further comprising recording said message prior to said playing (500a Fig.6)

Regarding claim 24, Casellini teaches the method of claim 11, wherein step(e) further comprises the steps of:  
establishing an audio connection between said call server and the subscriber, without further action on the part of the caller; and bridging the call onto said audio connection (500a Fig.6; options 1, 2, 4, or 5 bridges the audio call and does not require further caller action).

Regarding claim 26, Casellini teaches the method of claim 24, wherein said establishing an audio connection comprises establishing an audio connection between said call server and a communication device on which the subscriber received said first instant message (500a Fig.6; options 1, 2, 4, or 5 establishes an audio connection between call server and a communication device)

Regarding claim 27, Casellini teaches the method of claim 11, wherein said selected call handling option comprises taking a voicemail message from the caller and said handling the call comprises:  
connecting the call to a voice recording module; and recording a message from the caller (500a Fig.6).

Regarding claim 28, Casellini teaches the method of claim 27, wherein the subscriber chooses to screen said voicemail message, the method further comprising establishing an audio connection between said call server and the subscriber; and bridging said audio connection onto said voice recording connection (*101a and 500a Fig.6 and col.4 lines 1-13*))

Regarding claim 30, Casellini teaches a call control system for handling calls in real-time, comprising:  
a call receiver module configured to receive a call directed to a subscriber, a database of subscriber profiles, wherein a profile for a first subscriber includes one or more user names of the first subscriber for one or more instant messaging systems (303-311 Fig.3 and col.4 lines 14-27).  
an instant messaging module configured to send an initial instant messaging message to the first subscriber in response to receipt of a call for the first subscriber from a caller, wherein said initial instant messaging message includes a set of options for handling the call (209-210 Fig.4A and Fig.6);  
a voicemail module configured to record an incoming message from the caller if the first subscriber selects a voicemail option for handling the call(500a option 2 of fig.6); and a

message playback module configured to play an outgoing message for the caller if the first subscriber selects a message playback option for handling the call (500a option 4 of Fig.6)

an audio module configured to establish an audio connection with the first subscriber if the first subscriber selects a call handling option for answering the call, audio module being further configured to establish an audio connection with the first subscriber if the first subscriber selects a voicemail with screening option for handling the call(500a option 2 of Fig.6 and col. 4 lines 5-13); and

at least one text-to-speech(500b Fig.6) and speech-to-text(101a Fig.6; this is not limited by origin) conversion modules which, along with other components of the system, enable verbal-textual communication between the first subscriber and the caller over the instant messaging system being used by the first subscriber (Fig.3, Fig.6; at least one text-to-speech module is used).

Regarding claim 31, Casellini teaches the call control system of claim 30, wherein one or more of said call handling options in said initial instant messaging message comprise hyperlinks to the call control system (500a Fig.6)

Regarding claim 32, Casellini teaches the call control system of claim 31, further comprising a network server configured to receive a communication connection from the first subscriber initiated by the first subscriber's selection of one of said hyperlink call handling options (500a Fig.6 and col.5 lines 6-24)

Regarding claim 33, Casellini teaches the call control system of claim 30, wherein said instant messaging module is further configured to receive a return instant

messaging message from the first subscriber, wherein said return instant messaging message includes a selection of one of said call handling options (Fig.6).

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-3, 5-9, 11-24, and 26-33 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP  
May 3, 2004



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

